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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,584

11/14/2003

Kenneth J. Kotlowski

1458-P0009

1682

34456

7590

08/15/2006

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EXAMINER

RAY, GOPAL C

ART UNIT

PAPER NUMBER

2111

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/714,584

Applicant(s)

KOTLOWSKI ET AL.

Examiner

Gopal C. Ray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 11-13 and 24 is/are rejected.
- 7) ☒ Claim(s) 2-10 and 14-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/2/04, 6/7/04 and 9/17/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Applicant's election with traverse of Group I, claims 1-12 in the reply filed on 7/7/06 is acknowledged. The traversal is on the ground(s) that applicant believes the examination of all of the claims is not to create an undue burden on the USPTO and the subject matter among the groups is not independent and distinct as required by statute. The argument is found persuasive. Claims 1-24 are presented for examination.
2. The drawings filed on 11/14/03 are acceptable by the examiner for examination purposes. However, the Office of Initial Patent Examination (OIPE) reviews drawings initially for publication purposes. Direct any inquiries concerning drawing review for publication purposes to the Office of Initial Patent Examination (OIPE). See MPEP 507 for detail information.
4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
5. Claim 22 is objected to because the phrase, "the third external port and the fourth external port" in lines 1-2 lacks proper antecedent basis. Claim 24 is objected to because the word "meads" in line 4 should be changed to --means--. Furthermore, all claims should be revised carefully to eliminate all grammatical errors and antecedent basis problems.
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 11-13 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,415,344 granted to Jones et al.

As per claim 1, the reference of Jones et al. teaches “a system on a chip (SOC)” in Fig. 1 and col. 3, lines 32-33; “a first MSR command comprising a first destination address and a first destination data” in Fig. 6 and col. 8, lines 22-24; “providing, in response to executing the first MSR access command, a first access request including the first destination address and the first destination data and the external device being external the SOC” in Fig. 1 and col. 4, lines 39-53.

As per claim 11, the reference of Jones et al. teaches “wherein providing the first access request to the external bus port further comprises a peripheral interface module providing the first access request” in col. 19, lines 30-31.

As per claim 12, the reference of Jones et al. teaches “accessing a first external peripheral when the first destination address has a first value; and accessing a second external peripheral when the first destination address has a second value” in col. 8, lines 24-29.

As per claim 13, the claim recites an apparatus. However, the limitations are parallel to the limitations of claim 1. Therefore, in teaching the construction and use of the device, US Patent 6,415,344 granted to Jones et al. teaches a corresponding apparatus.

As per claim 24, the claim recites a system and is written in “means plus function” format. However, the limitations are parallel to the limitations of claim 1.

Therefore, in teaching the construction and use of the device, US Patent 6,415,344 granted to Jones et al. teaches a corresponding system.

8. Dependent claims 2-10 and 14-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an Examiner's Statement of Reasons for Allowance:

The claimed invention is directed to "a system and a method for machine specific register addressing in external". The examiner has done complete search and found no prior art of record, alone or in combination, teaches or fairly suggests additional limitation(s) of each dependent claim such as "providing, in response to executing the first MSR access command, a second access request including the first destination address and the first destination data to a bus interface module, wherein the bus interface module is part of the SOC; and wherein providing the first access request is further based on providing the second access request to the bus interface module" in claim 2, etc. in combination with other claimed elements in the respective parent claim. Therefore, the invention as claimed in dependent claims 2-10 and 14-23 is considered allowable because combinations recited in the claims are patentably distinguished from the prior art of record.

Any comments considered necessary by applicant must be submitted in response to this office action to avoid processing delays. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure.

The prior art submitted by applicant on 6/2/04, 6/7/04 and 9/17/04 has been considered by the examiner and made of record in the file. If applicants are aware of any prior art better than those are of record, they are required to bring the prior art to the attention of the examiner. Applicants are also reminded that each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in 37 CFR 1.56. Applicants are advised to submit any information material to patentability in accordance with 37 CFR 1.97 and 1.98.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (571) 272-3631. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (571) 272-3632. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[mark.rinehart@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC central telephone number is (571) 272-2100. Moreover, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lastly, paper copies of cited U.S. Patents and Patent Application Publications ceased to be mailed to applicants with office actions as of June 2004. Paper copies of Foreign Patents and Non-Patent Literature will continue to be included with office

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actions. These cited U.S. Patents and Patent Application Publications are available for download via Office's PAIR. As an alternate source, all U.S. Patents and Patent Application Publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the office of Public Records and from commercial sources. Applicants are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. Patent or Patent Application Publications will not be granted.

*Gopal C. Ray*  
**GOPAL C. RAY  
PRIMARY EXAMINER  
GROUP 2100**